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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/501,208 | 05/19/2005 | Steve C Benesi | SCB-03-1-PCT-US | 3477 |

7590
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Lafayette, CA 94549

03/31/2009

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| EXAMINER |
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POPOVICS, ROBERT J

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| ART UNIT | PAPER NUMBER |
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1797

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| MAIL DATE | DELIVERY MODE |
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03/31/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|--------------------------------------|--|
| Office Action Summary | Application No. 10/501,208 | Applicant(s) BENESI ET AL. | |
| | Examiner /Robert James Popovics/ | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The **listing of references in the specification** is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, **they have not been considered**.

MPEP § 2001.06(b) [R-2] Information Relating to or From Copending United States Patent Applications

The individuals covered by **37 CFR 1.56** have a duty to bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications which are "material to patentability" of the application in question. As set forth by the court in *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 (7th Cir. 1972):

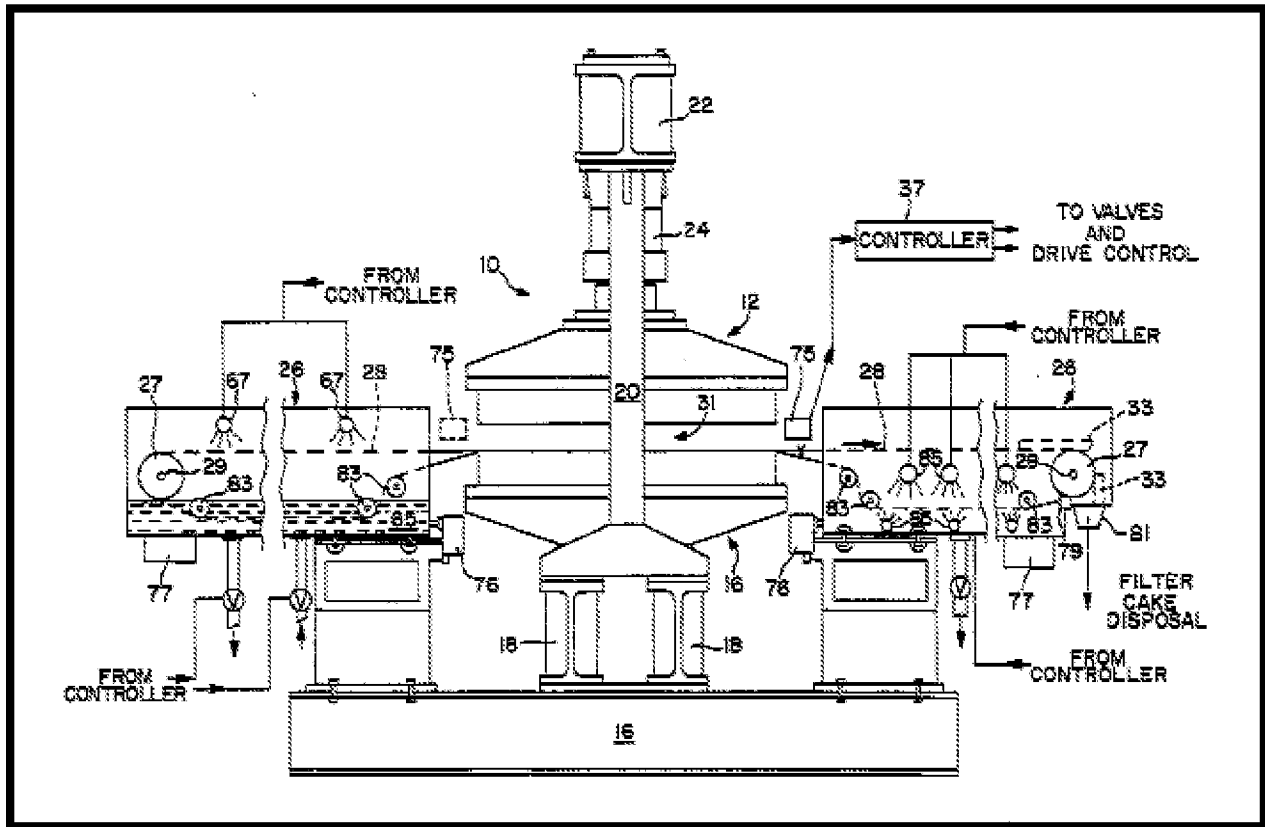
[W]e think that it is unfair to the busy examiner, no matter how diligent and well informed he may be, to assume that he retains details of every pending file in his mind when he is reviewing a particular application . . . [T]he applicant has the burden of presenting the examiner with a complete and accurate record to support the allowance of letters patent.

See also MPEP § 2004, paragraph 9.

Accordingly, the individuals covered by 37 CFR 1.56 cannot assume that the examiner of a particular application is necessarily aware of **other applications** which are "material to patentability" of the application in question, but must instead bring such other applications to the attention of the examiner. >See *Dayco Prod., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1365-69, 66 USPQ2d 1801, 1806-08 (Fed. Cir. 2003).< For example, if a particular inventor has different applications pending in which similar subject matter but patentably indistinct claims are present that fact must be disclosed to the examiner of each of the involved applications. Similarly, the prior art references from one application must be made of record in another subsequent application if such prior art references are "material to patentability" of the subsequent application.>See *Dayco Prod.*, 329 F.3d at 1369, 66 USPQ2d at 1808.

Claim Rejections - 35 USC § 102/103

Claims **39-74** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ***Benesi (US 5,462,677)***:



Applicants' Admissions Are Noted

Drafting a claim in Jepson format (i.e., the format described in 37 CFR 1.75(e); see MPEP § 608.01(m)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 534 (CCPA 1982) (holding preamble of Jepson-type claim to be admitted prior art where applicant's specification credited another as the inventor of the subject matter of the preamble).

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Claims **39-74** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Benesi (US 6,159,359)**. See for example, Figures 1-11. Also, the following teachings are noted:

(23) The filter modules having means for introducing slurry materials, wash materials and gas pressure materials adaptable for increases of pressure and flow to optimize operation as resistance to flow of slurry, cake wash or dewatering increases.

(24) Means for sensing and adjusting optimum operating conditions (flow meters, totalizers, fixed volume tanks, pressure switches, transmitters, variable drive pumps with capabilities of "ramping up" to meet slurry or cakewash requirements).

(25) The modules may be designed to provide optimum chamber depth and configuration and inlet configuration to optimize operation of each slurry.

(26) Means for introducing materials in equal or higher pressure until free liquid has cleared filtered solids, so as not to interrupt flow through solids or to disturb the uniform path of resistance in the cake.

(27) The modules can be designed with **input dried compressed air, compressed gas, superheated steam, hot dry air or gas, or a combination of these materials.**

(28) The modules and their controls can be designed to provide multiple wash/leach/dewatering operations in one filter cycle.

(29) The control of the units can be set by flow threshold through cake, by pressure of **gas flow through the filter cake, by time of gas flow through the filter cake, by volume of gas flow through the cake as means for determining when a optimum dry filter cake has been produced.**

(30) The individual filter plate members may be designed to provide the optimum filter chamber depth for different input slurry materials with the objective of producing a desired thickness of filter cake.

(31) The control system can be designed to introduce the slurry materials at a desired pressure and with input stopped when a predetermined pressure has been achieved, the cakewash liquid at a pressure higher than the slurry input pressure and terminated when the back pressure reaches a predetermined

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pressure, and the blowdown gas at a greater pressure than the cakewash pressure and terminated when blowdown gas has driven the wash liquid out of the cake and a desired dryness has been achieved.

Claim Rejections - 35 USC § 112

Claims **39-74** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Filed JULY 9, 2004

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1 and means for moving said filter medium through said filtration chamber when said filtration

2 chamber is open for discharging said slurry solids cake (104) from said apparatus, the

3 improvement characterized by the method steps of;

4 a) closing said upper and lower plates to establish said filtration chamber with said filter

5 medium between said continuously mating surfaces

6 b) uniformly distributing said quantity of slurry (124,B,108) in said at least one filtration

7 chamber (120);

8 c) introducing a hot gas fluid (126,A,108) into said filtration chamber to displace slurry

9 liquids from said slurry and to form said substantially dry filter cake on said filter medium,

10 d) opening said filtration chamber by relatively moving said upper and lower plates,

11 e) then moving said filter medium through said open chamber, and

12 f) discharging (104) said dry filter cake from said filtration chamber on said filter medium,

It is unclear how steps a, b, d, e and f, encircled above, can constitute “***an improvement,***” when the structure to perform these steps is admitted prior art by virtue of the Jepson claim format used.

It is unclear what Applicants intend when using the relative and subjective term **"hot"** in those claims in which it appears. Its relative and subjective nature has rendered those claims vague and indefinite, because the metes and bounds of patent protection sought cannot be ascertained.

In claim 60, it is unclear whether Applicants intend the recitation, "characterized by;" to be "open" or "closed." Replacement with conventional U.S. patent transitional phrase nomenclature is urged.

Claim Rejections - 35 USC § 103

Claims **39-74** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of ***Benesi (US 5,462,677)*** and ***Benesi (US 6,159,359)***.

It is submitted that any claim limitations that arguably may not be found in either one of these references would be found in the other, and that incorporation of the limitation in the other would have been obvious at the time the invention was made.

Any inquiry concerning this communication should be directed to /Robert James Popovics/ at telephone number (571) 272-1164.

**/Robert James Popovics/
Primary Examiner
Art Unit 1797**